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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,008	04/19/2004	William Darl Keehler	WHEEL2	2511

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INVENTIONS UNLIMITED
575 WEST MADISON STREET
APT. 4406 TOWERS 2
CHICAGO, IL 60661-2621

EXAMINER

BELLINGER, JASON R

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,008

Applicant(s)

KEEHLER ET AL.

Examiner

Jason R. Bellinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the insert formed as a base metal covered by a different material, as set forth in claim 14, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show an aperture on the insert in Figures 15-16 as described in paragraphs 0072 & 0073 of the

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specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In the instant case, Figures 4, 7, and 13-14 lack details of the depth and configuration of the apertures within the insert body. Furthermore, Figures 9-12 and 20-21 lack details showing how the mounting apertures extend out through the sides of the inserts. As currently shown, the mounting apertures seem to simply extend into the face of the insert and as such would not be capable of allowing a fastener to connect with the mounting apertures within the wheel portion.

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4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 1030, 1240, 1570, 1530, 1540, and 2203. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 1740, 1820, 1940, 2060, 2160, 2230, and 2270. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

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the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claims 1, 4, and 6 are objected to because of the following informalities: A hyphen (-) should be inserted between the terms "tire" and "engaging" in lines 1 and 3 of claim 1. A hyphen (-) should be inserted between the terms "axle" and "engaging" in lines 2 and 3 of claim 1. The term "inserts" should be replaced with the term --insert-- in line 6 of the claim.

The term --of-- should be inserted between the terms "plurality" and "wheel" in line 2 of claim 4.

A hyphen (-) should be inserted between the terms "tire" and "engaging" in lines 2 and 3 of claim 6. A hyphen (-) should be inserted between the terms "axle" and "engaging" in lines 2 and 4 of claim 6.

These corrections are for grammatical clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Claim 1 is indefinite due to the fact that the phrases "a wheel insert" and "an aperture" set forth in line 10 of the claim are double recitations. Both of these limitations have been previously set forth in line 6 and 5, respectively. Therefore, it is unclear whether the "wheel insert" and "aperture" set forth in line 10 are the same elements as those previously set forth, or additional elements of the invention.

Claim 4 is indefinite for the same reasons as set forth for claim 1 above, regarding the phrases "a plurality of wheel inserts" and "a plurality of apertures".

Claim 5 is indefinite due to the fact that the phrases "a plurality of wheel inserts" and "a plurality of apertures" are triple recitations. These limitations have been previously set forth in claim 1. Therefore, it is unclear whether the limitations set forth in claim 5 are the same that those set forth in claim 1, or additional elements of the invention.

Claim 6 is indefinite due to the fact that it is unclear what element of the invention is being referred to as "the rear".

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

10. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lyon ('038). Lyon shows a wheel 1 having a tire-engaging portion (2-4), an axle-engaging portion (11-12) with a plurality of lug-receiving openings 13, and a connecting portion 9 extending between the tire-engaging portion (2-4) and axle-engaging portion (11-12). The connecting portion 9 includes front and rear sides, and a plurality of apertures 8 extending from the front side through to the rear side. At least one wheel insert (collectively 20 & 22) is insertable into at least one of the plurality of apertures 8. The wheel insert (20 & 22) includes front and rear insert sides. The wheel insert (20 & 22) is inserted into the aperture 8 from the front side of the connecting portion 9 of the wheel 1. A plurality of inserts (namely element 22 of the wheel insert) is secured in a plurality of the wheel apertures 8. A plurality of wheel inserts (20 & 22) would be secured into a plurality of apertures 8 of a plurality of wheels 1.

11. Claims 8 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by White. White shows a wheel insert 34 for insertion into an aperture 32 of a wheel, wherein the insert 34 includes front and rear sides. The insert 34 fits into and substantially fills the aperture 32 in the wheel. The insert 34 includes a fastening mechanism (namely the press fit of axially extending legs) for securing the insert 34 to the wheel. The insert 34 includes at least one edge that cooperatively mates with an interior edge of the aperture 32 of the wheel.

12. Claims 1-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Weckman, Jr. et al.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Weckman, Jr. et al contains all of the limitations of the aforementioned pending claims.

13. Claims 1-13 and 15-17 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Weckman, Jr. et al (a publication of parent application 10/358,930) has common inventors with the instant application, and contains all the limitations of the aforementioned pending claims. The instant application does not reference William Weckman, Jr. as a co-inventor with William Keehler and Fredrick French III (as the parent application does).

Evidence should therefore be provided to show which portion(s) of the invention of the instant application was invented by the inventors William Keehler and Fredrick French III and not by William Weckman, Jr.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Botterman et al. White contains all of the limitations as set forth in paragraph 11 above, but does not show the portion of the insert exposed to view (the front side of the insert) having design indicia disposed thereon. Botterman et al teaches the use of an insert 132 having a front face exposed to view having a design indicia 237 disposed thereon. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the insert of White with indicia on the exposed front face for increasing the visual appearance of the wheel and/or providing information.

16. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Van Houten. White does not disclose the type of material from which the insert is fabricated.

Van Houten teaches the use of an insert 50 that may be made from the same of different material as that of the wheel, and include materials such as transparent or opaque colored plastic, metal, metal alloys, and composite material. The material could

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also be a base material, such as plastic or metal, that is covered with another material (such as chrome plating, etc). [See column 4, lines 59-67]

Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the insert of White from any suitable material, dependent upon cost, desired appearance, ease of machining, availability, etc.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered to show wheels having inserts secured within apertures of the wheel. For example, Lyon ('630) shows a wheel of the type described above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R. Bellinger whose telephone number is 703-308-6298. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger
Examiner
Art Unit 3617

JASON R. BELLINGER
PATENT EXAMINER

jrb *JRB*
8/11/05